

REMARKS

Claims 1-62 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added.

Improper Request for Election of Species

Applicants respectfully submit that the Examiner's requirement for an Election of Species at such a late stage in prosecution is improper. In the present case, the Examiner has already made a Restriction Requirement, a first Office Action on the merits and a Final Office Action on the merits. In the Interview Summary dated June 10, 2003, the Examiner requested that Applicants respond to the outstanding Final Office Action in a Continuation Application. Thus, on August 4, 2003, Applicants filed a Request for Continued Examination with a Reply under 37 CFR 1.111. No amendments were made in this most recent Reply.

Now, the Examiner has required an Election of Species. MPEP §808.01(a) states that "[e]lection of species should be required prior to a search on the merits (A) in all applications containing claims to a plurality of species with no generic claims and (B) in all applications containing both species claims and generic or Markush claims."

The fact that the present application is not currently under a Final Rejection and an RCE has been filed does not mean that

the Examiner has not conducted a search on the merits. Applicants direct the Examiner's attention to the Office Action dated February 14, 2002 and the Final Office Action dated October 3, 2002. These were certainly actions on the merits. By making an Election of Species requirement at this stage, the Examiner is placing an additional burden on Applicants when the pending claims were presumably already searched and considered. Indeed, the Examiner has already rejected the claims based upon prior art. At the very least the Examiner is subjecting the present application to piecemeal examination pursuant to MPEP § 707.07(g).

In view of the untimely nature of the Examiner's Election of Species Requirement, Applicants request that the Examiner withdraw the Requirement and search and consider all species. However, since Applicants are required to make an election in order to be fully responsive, the following comments are submitted.

The Examiner has requested election of one of the following species for the Image Receiving Layer:

Species A comprising polyvinyl alcohol, amine polymer, thermoplastic polymer, thermoplastic elastomer and an antioxidant;

Species B comprising an oxidized polyethylene homopolymer;

Species C comprising ethylene vinyl acetate copolymer

powder; and

Species D comprising ethylene acrylic acid copolymer dispersion.

Applicants hereby elect species C for the Image Receiving Layer.

The Examiner has also requested election of one of the Adhesion Layer:

Species E comprising an acrylic dispersion, an elastomeric emulsion, a water repellent and a plasticizer; and

Species F comprising a film forming binder, an elastomeric emulsion, a water repellent and a plasticizer.

Applicants hereby elect species E for the Adhesion Layer.

It is Applicants understanding that the elections above will serve as a starting point for search and consideration by the Examiner. Upon indication of allowable subject matter, the Examiner must expand the search to include other non-elected species with the intent of finding the generic claim ultimately allowable.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No. 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees

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required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17;
particularly, extension of time fees.

Respectfully submitted,

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By 

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